



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/345,448	07/01/1999	DOUGLAS WALTER CONMY		1268

29315 7590 02/20/2003

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILL ROAD
SUITE 900
RESTON, VA 20190

EXAMINER

LY, ANH

ART UNIT PAPER NUMBER

2172

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/345,448

Applicant(s)

CONMY ET AL.

Examiner

Anh Ly

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11-19 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-19 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 12/27/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/345,448 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 5, 10 and 20 have been cancelled (page #15 dated 07/09/2002).
3. Claims 33-35 have been added.
4. Claims 1-4, 6-9, 11-19 and 21-35 are pending in this application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 6, 11, 16 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,913,032 issued to Schwartz et al. (herein Schwartz) in view of US Patent No. 6,044,372 issued to Rothfus et al. (hereinafter Rothfus).

With respect to claim 1, Swartz discloses one non-web document from at least one database (such as Lotus Notes, col. 16-lines 65-67, col. 17, lines 1-67 and col. 21, lines 15-55); a selection formula, and presented to the user at various intervals without additional user intervention (such as formulas, macros and commands in a cell of a spreadsheet, col. 9, lines 25-45, col. 16, lines 55-67 and col. 17, lines 1-12); subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve; search performing means for performing a search of the at least one database for information matching the subscription; subscription retrieving means for retrieving the information matching the subscription; and subscription notification means for notifying the user of matched and retrieved information (col. 3, lines 52-67, col. 7, lines 1-5, col. 11, lines 1-36, col. 15, lines 56-67, col. 16, lines 1-10, col. 20, lines 22-32, col. 40, lines 15-67 and col. 48, lines 35-45).

Schwartz does not explicitly indicate, "wherein the selection formula is programmed with search criteria corresponding to the subscription search criteria

identify information to be searched for subscription requesting means for enabling a user to request a subscription.”

However, Rothfus discloses search subscription request permission (col. 10, lines 25-32); and subscription requesting means for enabling a user to request a subscription (see fig. 7A, 7B and 8, col. 13, lines 1-41).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz with the teachings of Rothfus so as to have a system for user to request a subscription because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 6, Swartz discloses one non-web document from at least one database (such as Lotus Notes, col. 16-lines 65-67, col. 17, lines 1-67 and col. 21, lines 15-55); a selection formula, and presented to the user at various intervals without additional user intervention (such as formulas, macros and commands in a cell of a spreadsheet, col. 9, lines 25-45, col. 16, lines 55-67 and col. 17, lines 1-12); subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve; search performing means for performing a search of the at least one database for information matching the subscription; subscription retrieving means for retrieving the information matching the subscription; and subscription

notification means for notifying the user of matched and retrieved information (col. 3, lines 52-67, col. 7, lines 1-5, col. 11, lines 1-36, col. 15, lines 56-67, col. 16, lines 1-10, col. 20, lines 22-32, col. 40, lines 15-67 and col. 48, lines 35-45).

Schwartz does not explicitly indicate, "wherein the selection formula is programmed with search criteria corresponding to the subscription search criteria identify information to be searched for subscription requesting means for enabling a user to request a subscription."

However, Rothfus discloses search subscription request permission (col. 10, lines 25-32); and subscription requesting means for enabling a user to request a subscription (see fig. 7A, 7B and 8, col. 13, lines 1-41).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz with the teachings of Rothfus so as to have a system for user to request a subscription because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

Claim 11 is essentially the same as claim 1 except that it is directed to a method rather than a system ('032 of such as Lotus Notes, col. 16-lines 65-67, col. 17, lines 1-67 and col. 21, lines 15-55; such as formulas, macros and commands in a cell of a spreadsheet, col. 9, lines 25-45, col. 16, lines 55-67 and col. 17, lines 1-12; col. 3, lines 52-67, col. 7, lines 1-5, col. 11, lines 1-36, col. 15, lines 56-67, col. 16, lines 1-10, col.

Art Unit: 2172

20, lines 22-32, col. 40, lines 15-67 and col. 48, lines 35-45; and '372 of col. 10, lines 25-32 and see fig. 7A, 7B and 8, col. 13, lines 1-41; col. 4, lines 31-34), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 16 is essentially the same as claim 1 except that it is directed to a processor readable medium rather than a system ('032 of such as Lotus Notes, col. 16- lines 65-67, col. 17, lines 1-67 and col. 21, lines 15-55; such as formulas, macros and commands in a cell of a spreadsheet, col. 9, lines 25-45, col. 16, lines 55-67 and col. 17, lines 1-12; col. 3, lines 52-67, col. 7, lines 1-5, col. 11, lines 1-36, col. 15, lines 56-67, col. 16, lines 1-10, col. 20, lines 22-32, col. 40, lines 15-67 and col. 48, lines 35-45; and '372 of col. 10, lines 25-32; see fig. 7A, 7B and 8, col. 13, lines 1-41; col. 4, lines 31-34), and is rejected for the same reason as applied to the claim 1 hereinabove.

With respect to claims 33-35, Schwartz discloses syntax checking means for determining whether code input in the programmed selection formula is correct (col. 9, lines 51-41 and col. 10, lines 39-46); further comprising subscription disabling means for temporarily discontinuing the subscription for a predetermined period of time (col. 15, lines 9-12; also see col. 7, lines 3-5); and wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text (col. 16, lines 16-32).

8. Claims 2-3, 7-8, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,913,032 issued to Schwartz et al. (herein Schwartz) in view of US Patent No. 6,044,372 issued to Rothfus et al. (hereinafter Rothfus) in view of US Patent No. 6,141,653 issued to Conklin et al. (hereinafter Conklin).

With respect to claims 2-3, 7-8, Schwartz in view of Rothfus discloses a system as discussed in claims 1 and 6.

Schwartz in view of Rothfus does not disclose explicitly indicate, "the search of the at least one database on a random basis."

However, Conklin discloses the search of the at least one database on a random basis as claimed (col. 29, lines 12-47).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Conklin so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

Claim 14 is essentially the same as claim 2 except that it is directed to a method rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 15 is essentially the same as claim 3 except that it is directed to a method

rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 17 is essentially the same as claim 2 except that it is directed to a medium rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 18 is essentially the same as claim 3 except that it is directed to a medium rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 3 hereinabove.

9. Claims 4, 9, 12-13, 19, and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,913,032 issued to Schwartz et al. (herein Schwartz) in view of US Patent No. 6,044,372 issued to Rothfus et al. (hereinafter Rothfus) in view of US Patent No. 6,020,980 issued to Freeman.

With respect to claims 4 and 9, Schwartz in view of Rothfus discloses a system as discussed in claims 1 and 6.

Schwartz in view of Rothfus does not disclose explicitly indicate, "the input means for enabling a user to input one or more options relating to the subscription."

However, Freeman discloses the input as claimed (col. 10, lines 38-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic

Art Unit: 2172

information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 12, Schwartz in view of Rothfus discloses a system as discussed in claim 11.

Schwartz in view of Rothfus does not disclose explicitly indicate, "subscription presenting means for presenting the subscription to the user."

However, Freeman discloses the subscription presenting means as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 13, Schwartz in view of Rothfus discloses the step of periodically searching the at least one database (col. 14, lines 6-22).

Claim 19 is essentially the same as claim 4 except that it is directed to a medium rather than a system (col. 10, 38-54), and is rejected for the same reason as applied to the claim 4 hereinabove.

With respect to claim 21, Schwartz in view of Rothfus discloses a system as discussed in claim 1.

Schwartz in view of Rothfus does not disclose explicitly indicate, "at least one database is a Lotus Notes database."

However, Freeman discloses the Lotus Notes as claimed (col. 4, lines 36-67, and col. 5, lines 1-6).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 22, Schwartz in view of Rothfus discloses a system as discussed in claim 1.

Schwartz in view of Rothfus does not disclose explicitly indicate, "subscription presenting means for presenting the subscription to the user."

However, Freeman discloses the subscription presenting means as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of

Art Unit: 2172

Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 23, Schwartz in view of Rothfus discloses a system as discussed in claim 1.

Schwartz in view of Rothfus does not disclose explicitly indicate, "subscription presenting means presents the subscription as an electronic mail message."

However, Freeman discloses the email message as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 24, Schwartz in view of Rothfus discloses a system as discussed in claim 6.

Schwartz in view of Rothfus does not disclose explicitly indicate, "at least one database is a Lotus Notes database."

However, Freeman discloses the Lotus Notes as claimed (col. 4, lines 36-67, and col. 5, lines 1-6).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 25, Schwartz in view of Rothfus discloses a system as discussed in claim 6.

Rothfus does not disclose explicitly indicate, "subscription presenting means for presenting the subscription to the user."

However, Freeman discloses the subscription presenting means as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwartz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the

combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

With respect to claim 26, Swartz in view of Rothfus discloses a system as discussed in claim 6.

Schwartz in view of Rothfus does not disclose explicitly indicate, "subscription presenting means presents the subscription as an electronic mail message."

However, Freeman discloses the email message as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schwarz in view of Rothfus with the teachings of Freeman so as to have the search performing means that performs the search of the at least one database on a random basis because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user in the in the user enabling to subscribe and update information via a network environment.

Claim 27 is essentially the same as claim 21 except that it is directed to a method rather than a system (col. 4, lines 36-67, and col. 5, lines 1-6), and is rejected for the same reason as applied to the claim 21 hereinabove.

Claim 28 is essentially the same as claim 22 except that it is directed to a method

rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 22 hereinabove.

Claim 29 is essentially the same as claim 23 except that it is directed to a method rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 23 hereinabove.

Claim 30 is essentially the same as claim 21 except that it is directed to a medium rather than a system (col. 4, lines 36-67, and col. 5, lines 1-6), and is rejected for the same reason as applied to the claim 21 hereinabove.

Claim 31 is essentially the same as claim 22 except that it is directed to a medium rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 22 hereinabove.

Claim 32 is essentially the same as claim 23 except that it is directed to a medium rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 23 hereinabove.

Contact Information

10. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 or via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday – Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to: (703) 746-7238 (for After Final communications intended for entry)


or: (703) 746-7239 (for Official Fax Number)

or: (703) 746-7240 (for Customer Service center or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

AL 
Feb. 6th, 2003.


HOSAIN T. ALAM
PRIMARY EXAMINER